



Attorney's Docket No. 6-276001 / LDSG/PHM/70675/US

6AU 1634

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : John C. Smith
Serial No. : 09/778,900
Filed : February 8, 2001
Title : DIAGNOSTIC METHOD

Art Unit : 1634
Examiner : Juliet C. Einsmann

Commissioner for Patents
Washington, D.C. 20231

RECEIVED
NOV 06 2002
TECH CENTER 1600/2900
#12/B
CD
11/7/02

RESPONSE TO RESTRICTION REQUIREMENT

Responsive to the action mailed September 26, 2002, please amend the application as follows.

In the claims:

Add new claim 20.

20. The method of claim 1, wherein the nucleotides at all of the following nucleotide positions are determined: positions 1953, 3453 and 3888 as defined by the positions in EMBL accession number X51602; positions 519, 786, 1422 and 1429 as defined by the positions in EMBL accession number D64016; position 454 as defined by the position in SEQ ID NO. 3; and position 696 as defined by the position in SEQ ID NO. 5.

B1

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, Washington, D.C. 20231.

Date of Deposit

Signature

Typed or Printed Name of Person Signing Certificate

October 28, 2002

Joanne D. Boyle

Joanne D. Boyle

Applicant : John C. Smith
Serial No. : 09/778,900
Filed : February 8, 2001
Page : 2

Attorney's Docket No.: 5-276001 / LDSG/PHM/70675/US

REMARKS

Claims 1-20 are now pending in the application, new claim 20 having been added by the above amendment. Support for this claim can be found in claim 1 as originally filed, as well as on page 9, lines 9-11 of the specification.

Applicant elects the invention of Group 1 (claims 1, 2, 3, 4, 5, 6, 7, and 19) drawn to a method for the diagnosis of a polymorphism using nucleic acid analysis, diagnosis of a disease, and treatment of a disease, classified in class 435, subclass 6. Further, Applicant elects the SNP at position 3888 according to the position defined by EMBL Accession No. X51602 for examination. This election, however, is made with traverse.

Applicant notes that claim 1 covers determining the sequence "at one or more" of the nine nucleotide positions. If the restriction requirement restricting the nine polymorphisms into nine separate groups is allowed to stand, it will limit Applicant to claiming a method of determining the sequence at only a single one of the nine positions. The restriction requirement ignores those embodiments of the claims in which the sequence at two (or three, or four, up to nine) positions is determined. It essentially prohibits Applicant from presenting claims limited to such embodiments in this application or any divisional. An example of such a claim is submitted as a new claim 20 above. As this claim is dependent on claim 1, it must be included in the elected group. However, it clearly will require examination of all nine polymorphisms. Applicant fails to see how the restriction requirement, as presently formulated, can stand in view of new claim 20.

Applicant protests and requests withdrawal of the restriction requirement with respect to restricting among the nine polymorphisms.

Applicant : John C. Smith
Serial No. : 09/778,900
Filed : February 8, 2001
Page : 3

Attorney's Docket No. 5-276001 / LDSG/PHM/70675/US

No fee is believed to be due. Any charges or credits may be applied to Deposit Account
No. 06-1050.

Respectfully submitted,

Date:

Oct. 28, 2002

Janis K. Fraser, Ph.D., J.D.
Reg. No. 34,819

Fish & Richardson P.C.
225 Franklin Street
Boston, Massachusetts 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906